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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/741,042	12/21/00	JUEN	M XA-8791B
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EXAMINER
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KUMAR, S

ART UNIT	PAPER NUMBER
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2675

DATE MAILED: 06/05/01

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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# Office Action Summary

Application No.  
09/741,042

Applicant(s)  
Juen et al.

Examiner  
Srlakshmi Kumar

Art Unit  
2675



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 30, 2001
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirements.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☒ The proposed drawing correction filed on Mar 20, 2001 is: a) ☒ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 20) ☐ Other: \_\_\_\_\_

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

2. Claims 1-3,6,7,9,10,12-14, and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Gove (U.S. 5,491,510).

Gove discloses an image processing apparatus comprising,

As to independent claim 1,

operation picture containing indicia corresponding to a plurality of image processing functions among which a selection can be made by an external operation (Column 2, lines 33-36, Column 3, lines 16-24),

display means for displaying said operation picture (Column 3, lines 47-48),

position input means, including a portion placed over a screen of said display means to detect a touch operation as said external operation, said position input means having a first operating mode to enter a position designated by the touch operation as an absolute position on the operation picture displayed on said display means (Column 2, lines 44-46, Column 3, lines 16-24)

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identifying means for identifying a selected image processing function, among said plurality of image processing functions, based on the position entered through said position input means (Column 2 lines 44-54, Column 2 line 66-Column 3 line 7, Column 3, lines 16-24),

image processing means for carrying out the image processing function identified by said identifying means (Column 3, lines 24-27),

output means for outputting operation picture produced by said operation picture producing means to an external display device (Column 3, lines 39-40),

position input means can operate in a second operating mode to enter the position designated by the touch operation as a relative position on the operation picture displayed on the external display device ( Column 3, lines 16-24).

As to independent Claim 7,

an operation picture producing portion which produces an operation picture containing indicia corresponding to a plurality of image processing functions among which a selection can be made by an operator (Column 2, lines 33-36, Column 3, lines 16-24),

an image display unit (Column 3, lines 47-48),

an output unit which outputs said operation picture to an external display device (Column 3, lines 39-40),

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a position input portion which inputs a position designated by the operator on the operation picture displayed on the external display device (Column 2, lines 44-46, Column 3, lines 16-24),

an identifying portion which identifies a selected image processing function, among said plurality of image processing functions, based on the designated position input by said position input portion (Column 2 lines 44-54, Column 2 line 66-Column 3 line 7, Column 3, lines 16-24),

an image processing portion which carries out the selected image processing function (Column 3, lines 24-27),

As to independent Claim 13,

operation picture containing indicia corresponding to a plurality of image processing functions among which a selection can be made by an external operation (Column 2, lines 33-36, Column 3, lines 16-24),

outputting the operation picture to the external display device (Column 3, line 47-48),

inputting a position designated by the operator on the operation picture displayed on the external display device (Column 2, lines 44-46, Column 3, lines 16-24),

identifying a selected image processing function, among said plurality of image processing functions, based on the input position ((Column 2 lines 44-54, Column 2 line 66-Column 3 line 7, Column 3, lines 16-24),

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performing the selected image processing function (Column 3, lines 24-27).

As to dependent Claim 2,

Claim 1 and further comprising,

display control means for turning off a display of the operation picture on said display means when the operation picture is output to the external display device through said output means (Column 1, lines 33-36, Column 3, lines 24-27),

Gove discloses the feature of a video camera and a processor capable of performing the necessary image processing and display control functions. The feature of turning off a display when picture is output to an external device is inherent to the Gove system as the display in the video camera will automatically turn off.

As to dependent Claim 3,

Claim 1 and further comprising,

image adding means for adding a cursor, indicating the position entered through said position input means, to the operation picture produced by said operation picture producing means and supplied to said output means (Column 3, lines 16-27),

Gove discloses the feature of a processor capable of processing inputs from the user. The feature of a cursor is inherent to the Gove system as any processor would routinely have a cursor.

As to dependent Claim 6, 12, and 17,

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Claims 1, 7, and 13, respectively, and further comprising,

image processing apparatus is an electronic camera (Column 2, lines 33-36),

As to dependent Claims 9 and 14,

Claims 7 and 13, respectively, and further comprising,

position is designated by the operator performing a touch operation of a touch responsive unit having a touch portion placed over a screen of said image display unit (Column 2, lines 44-46, Column 3, lines 16-24).

As to dependent Claim 10,

Claim 9 and further comprising,

said image display unit is connected to said operation picture producing portion to display the operation picture, said position input portion has a first operating mode to input a position designated by the operator via said touch responsive unit on the operation picture displayed on said image display unit, and a second operating mode to input a position designated by the operator via said touch responsive unit on the operation picture displayed on the external display device (Column 3, lines 16-24, 29-31)

Gove discloses a system where user inputs may be made via a touch responsive screen of a image display unit. It is inherent that the system is capable of outputting images to two different displays where each maybe able to receive input from the user.

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***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4, 5, 8-11, 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gove (U.S. 5,491,510) and further in view of Autry et al (U.S. 5,724,106).

As to dependent Claim 4,

Claim 1 and further comprising,

remote input means for allowing the external operation to be performed by a remote operation (Autry et al, Column 3, lines 41-51, 66-Column 4 line 1, 25-30),

wherein, when the operation picture is output to the external display device through said output means, said position input means operates in said second mode to enter the position designated by the remote operation as a relative position on the operation screen displayed on the external display device (Autry et al, Column 3, lines 41-51, 66-Column 4 line 1, 25-30),

identifying means identifies a selected image processing function among said plurality of image processing functions, based on the position entered through said remote (Autry et al, Column 3, lines 41-51, 66-Column 4 line 1, 25-30),



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Where Gove fails to teach a remote input means, Autry describes in column 3, lines 41-51, 66-column 4 line 1, 25-30. It is obvious to one skilled in the art that the remote input can easily be incorporated into the Gove system as both systems use a processor or computer to process and display data. A remote input is advantageous as there is no need for the user to remain at the computer to input data and such.

As to dependent Claim 5,

Claim 4 and further comprising,

image adding means for adding a cursor, indicating the position entered through said remote input means, to the operation picture produced by said operation picture producing means and supplied to said output means (Column 3, lines 41-48),

As per Claim 3, Gove discloses the feature of a cursor, but fails to teach a remote input device. Autry et al describes in Column 3, lines 41-48 the feature of a remote input device as well as a cursor. It is obvious to one skilled in the art that the remote input is easily incorporated into the Gove system and enables the user to input data without the need to remain at the computer.

As to dependent Claim 8,

Claim 7 and further comprising,

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said position input portion is constructed to input a position designated by the operator, on the operation picture displayed on the external display device, with a remote control which provides a signal to the position input portion (Column 3, lines 41-54, Column 4, lines 4-6),

Where Gove fails to teach, Autry describes in column 3, lines 41-54 and column 4, lines 4-6. It is obvious to one skilled in the art that the feature of a remote unit for controlling user inputs is capable of being incorporated into the Gove system as having the remote unit frees the user to move from one place to another while input information.

As to dependent Claim 11,

Claim 10 and further comprising,

said position input portion is constructed to input a position designated by the operator, on the operation picture displayed on the external display device, with a remote control which provides a signal to the position input portion (Column 3, lines 41-54, Column 4, lines 4-6),

Where Gove fails to teach, Autry describes in column 3, lines 41-54 and column 4, lines 4-6. It is obvious to one skilled in the art that the feature of a remote unit for controlling user inputs is capable of being incorporated into the Gove system as having the remote unit frees the user to move from one place to another while input information.

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As to dependent Claim 15,

Claim 13 and further comprising,

said position is designated by the operator with a remote control unit which provides a signal to the image processing apparatus (Column 4, lines 4-6),

Where Gove fails to teach a remote control unit that provides signals to the image processing apparatus, Autry et al describes in column 4, lines 4-5. It is obvious to one skilled in the art that the remote control unit is easily incorporated into the Gove system and enable the user to input data without the need to remain at the computer.

As to dependent Claim 16,

Claim 13 and further comprising,

said inputting constitutes one of two selectable inputting modes, the other of said inputting modes including inputting a position designated by the operator on the operation picture displayed on said image display unit (Column 4, lines 25-30),

Where Gove fails to teach, Autry et al clearly describes the operation of two mode in column 4, lines 25-30. It is obvious to one skilled in the art that the remote input device which is able to operate in two distinct modes can easily be incorporated into the Gove system. The ability to operate in to modes in advantageous as one function is being processed, another can be selected.

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*Response to Arguments*

5. Applicant's arguments filed March 30, 2001 have been fully considered but they are not persuasive.

With respect to claims 1, 7 and 13, applicant states that Gove does not disclose that the touch screen covers a portion of a display means that displays an operation picture that can also be output to an external display device. Gove teaches the use of a touch screen for input of marking of areas by a surgeon, in col. 3, lines 16-24, it would be inherent that the display screen would show the object to be marked, and provide a touch screen for input. As to the entered positions designated on the touch screen as absolute and relative positions on internally and externally displayed operation pictures, Gove teaches where the surgeon using the touch screen marks specific areas or positions on the image seen of the patient.

*Conclusion*

6. This is a continuation of applicant's earlier Application No. 08/994,756. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**Any response to this final action should be mailed to:**

**Box AF**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications; please mark "EXPEDITED  
PROCEDURE")

**Or:**

(703) 308-6606 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Srilakshmi Kumar** whose telephone number is (703) 306-5575. The examiner can normally be reached on Mondays through Fridays from 7:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Saras, can be reached on (703) 305-9720. The fax number is (703) 308-6606.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.

June 1, 2001



STEVEN SARAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600